

TLI/AAH/PAEL

PLEASE STAMP TO ACKNOWLEDGE RECEIPT OF THE FOLLOWING:

In Re Application of: Isabelle ROLLAT et al.

Application No.: 10/023,330

Group Art Unit: 1617

Filed: December 20, 2001

Examiner: Not assigned

For: RESHAPABLE HAIR STYLING RINSE COMPOSITION COMPRISING (METH)
ACRYLIC COPOLYMERS

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1. Information Disclosure Statement under 37 C.F.R. § 1.97(b)

Dated July 25, 2002

Docket No.: 05725.0922-00000

AAH:jab - J. Bachman, MD 222



(Due Date: N/A)

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PATENT
Customer Number 22,852
Attorney Docket No.: 05725.0922-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
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Isabelle ROLLAT et al.) Group Art Unit: 1617
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Application No.: 10/023,330) Examiner: not assigned
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Filed: December 20, 2001)
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For: RESHAPABLE HAIR STYLING)
RINSE COMPOSITION)
COMPRISING (METH)ACRYLIC)
COPOLYMERS)

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JUL 29 2002
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Assistant Commissioner for Patents
Washington, DC 20231

Sir:

INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. § 1.97(b)

Pursuant to 37 C.F.R. §§ 1.56 and 1.97(b), Applicants bring to the attention of the Examiner the following information. This Information Disclosure Statement is being filed to the undersigned's knowledge, before the mailing date of a first Office Action on the merits for the above-referenced application.

Applicants would like to bring to the Examiner's attention that the invention claimed in the above referenced application is associated with a Collaboration Agreement between the assignee of the application, L'Oréal, and a U.S. third party corporation. It is the wish of the signatories of the Agreement that the identity of the third party not be made public. In view of Applicants' duty to disclose information that may be material to the patentability of the application, Applicants present the following information regarding the collaboration and events leading to the filing of

the application. Applicants respectfully request that the Examiner acknowledge consideration of this information in the next PTO communication.

When the two parties entered into the collaboration, they recognized that L'Oréal had experience and expertise in cosmetology, had performed R&D work in the field of cosmetic products, had studied the innovative concept of reshapable hair products using adhesive materials, was interested in testing materials to evaluate and determine their possible use in reshapable hair products, and had the facilities and capabilities to test such materials. Likewise, the parties recognized that the third party had experience and expertise in chemical compounds, had performed R&D work in the field of polymers and other materials that could have applications in the field of cosmetic products, and had the facilities and capabilities to select and prepare candidate adhesive materials. Accordingly, the parties' objective for the Collaboration was for the third party to select candidate adhesive materials and for L'Oréal to evaluate such candidate adhesives and to develop any novel reshapable hair formulations based on any such adhesive.

This objective progressed as follows. L'Oréal provided to the third party target properties that L'Oréal believed necessary for an adhesive material to be useful in a reshapable hair formulation. After a period of investigation, the third party provided L'Oréal with a list of polymer classes as potential candidates, some of which were approved by L'Oréal for further development.

In this laboratory portion of the project, the third party began the development of adhesive materials falling within the general scope of the approved candidate classes. The third party supplied, free of charge, to L'Oréal samples of these

adhesives materials, as they were developed. The third party also provided information regarding its own testing of the adhesive materials, including testing that the third party believed may be predictive of its suitability for a reshapable hair styling formulation.

L'Oréal evaluated the adhesive materials and identified the most promising examples, and, in some instances, provided feedback to the third party to optimize the adhesive materials for use in formulations. L'Oréal determined that neither the third party's testing nor L'Oréal's preliminary testing of an adhesive sample was truly predictive of a reshapable effect for a formulation comprising the adhesive material. The only predictive testing was L'Oréal's *in vivo* testing, as described in the application, conducted under the direction and control of Mrs. Rollat, Mr. Samain, Mrs. Perron, and Mr. Restlé.

Applicants note that there had been a difference of opinion between L'Oréal and the third party regarding inventorship for the claimed invention of this and related applications. Both parties recognized that inventorship is a difficult determination to make in the context of a collaboration and agreed to allow attorneys of the undersigned attorney's law firm to make a determination. The facts underlying the development of the invention, as claimed, were investigated by those attorneys. The attorneys concluded that Mrs. Rollat, Mr. Samain, Mrs. Perron, and Mr. Restlé conceived of the compositions with a reshapable effect and, therefore are the inventors of the claimed invention. The inventorship determination was communicated to the parties orally. While the third party has orally indicated that some employees of the third party disagree with the legal conclusion, the third party

orally chose not to contest that determination by arbitration, which was their right under the Agreement, or by filing a paper in this application, as invited by Applicants.

The undersigned believes that this was a fair and impartial decision, particularly since under the Agreement, the ownership of the patent rights was predetermined, irrespective of the outcome of the inventorship investigation. Specifically, all rights to any application claiming a composition with a reshapable effect belong to L'Oréal, irrespective of who was the employer of the inventors. Nevertheless, in view of recent decisions of the Federal Circuit, Applicants believe their duty of disclosure to the PTO requires presentation of these facts to the Examiner.

The undersigned notes that there is no question that conception is the touchstone of inventorship. Hence, the underlying issue that was investigated was "who conceived of the claimed invention?" The claims of the above-referenced application are directed to compositions with a reshapable effect comprising a specific subclass of adhesive materials. Applicants do not question whether the third party invented the adhesive materials that were investigated by Mrs. Rollat, Mr. Samain, Mrs. Perron, and Mr. Restlé. However, Applicants submit that the conception of the adhesive material does not intersect with the conception of the reshapable hair styling composition. If that were always the case, all patent applications claiming cosmetic compositions would need to identify the individuals, who developed the compounds that are found in the claimed compositions, as co-inventors. That has not been the case in this field. Here, while the third party did provide test data regarding the adhesive materials, the initial concept of a

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reshapable product and the target properties for an adhesive were from L'Oréal. Further, it has been the experience of L'Oréal and, in particular, Mrs. Rollat, Mr. Samain, Mrs. Perron, and Mr. Restlé that this is a highly unpredictable art and that only their *in vivo* testing is truly predictive of a reshapable effect. In fact, it is possible that conception did not even occur until there was an actual reduction to practice, which was conducted under the control and supervision of only the named inventors, Mrs. Rollat, Mr. Samain, Mrs. Perron, and Mr. Restlé.

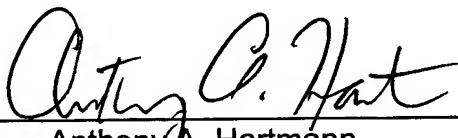
Applicants reserve the right to take appropriate action to establish the patentability of the disclosed invention over the above information, should the Examiner apply this information against the claims of the present application.

If there is any fee due in connection with the filing of this Statement, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 25, 2002

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